



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,070	02/14/2000	Terada Masayuki	10746/16	7453

26646 7590 09/29/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

LIPMAN, JACOB

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 09/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,070

Applicant(s)

MASAYUKI ET AL.

Examiner

Jacob Lipman

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4, 6, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Information Disclosure Statements of 2/14/00, 5/8/00, 11/5/02 and 1/22/03 have been considered in this office action.

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. A few examples of this are as follows:

Claim 1 recites "circulation system". It is unclear what circulation is intended.

Claim 1 recites the limitation "said data". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites "data corresponding to said second information". It is unclear what data is being verified here.

Claim 1 recites "when said issuer apparatus is valid". It is unclear if this is a pre-condition for something.

The remaining claims have similar problems and must be corrected.

Claims 14, 23, and 24 recite the limitation "said manifest". There is insufficient antecedent basis for this limitation in the claim.

Claim 20 repeats the same line twice.

Claim 54 recites "said user apparatus further comprising means for generating said originality information. It is unclear how the user apparatus will generate information that has already been generated by the issuer apparatus.

Claim 71 recites, "and second information corresponding to data or information corresponding to the data". There is no clear understanding of this limitation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-71, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Samson, US Patent number 5,287,408.

With regard to claims 1, 2, 9, 11, 14, 15, 17, 19-21, 23-25, 31-33, 40, 41, 45-51, 54, 55, 62, 63, and 67-71, Samson discloses a system comprising a device to generate

Art Unit: 2134

licenses corresponding to an issuer (column 3 lines 14-20), a corresponding program is sent with this license imbedded in it (column 3 lines 22-24). The receiving computer has a verifying means to verify the license is valid, thus the issuer, and program must be valid (column 5 39-46).

With regard to claims 3, 6 and 18, Samson discloses one objective of his method is to prevent unauthorized reproduction of digital information (column 2 lines 53-55).

With regard to claims 4, 7, 26, 34, 42, 56, 60, and 64, Samson discloses the license function is that of a verification key and signature.

With regard to claims 5, 8 and 10, Samson discloses the license can be stored in a tamper-proof device, such as read only memory (column 8 lines 3-8).

With regard to claims 12, 22, 27-30, 35-39, 53, 57-59 and 61, Samson discloses moving or copying the program and license to a new computer, thus allowing the new computer to verify the license (column 8 lines 9-16).

With regard to claims 13 and 16, Samson discloses verification of the license over a network (column 8 lines 8-30).

With regard to claims 43, 44, 65 and 66, Samson discloses the licenses are based on a one-way function (column 5 lines 28-33).

With regard to claim 52, Samson discloses that there is a count kept of the licenses issued (column 9 lines 42-46).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-


Art Unit: 2134

0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JL


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100